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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/000,330	05/20/1998	TORU NAKAMURA	514420-3596	5116
23416	7590	08/25/2004	EXAMINER	
CONNOLLY BOVE LODGE & HUTZ, LLP			DOTE, JANIS L.	
P O BOX 2207			ART UNIT	
WILMINGTON, DE 19899			PAPER NUMBER	
			1756	
DATE MAILED: 08/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/000,330

Applicant(s)

NAKAMURA ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

THE REPLY FILED 06 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached paragraph 2.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended; see attached, paragraph 1.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 16, 21, 24-30, and 35.
- Claim(s) withdrawn from consideration: _____
8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s).
10. ☐ Other: _____

Janis L. Dote
JANIS L. DOTE
PRIMARY EXAMINER
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1700

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1. The amendment filed Aug. 6, 2004, under 37 CFR 1.116 in reply to the final rejection will be entered upon the filing of an appeal, but is not deemed to place the application in condition for allowance. Upon filing of an appeal and entry of the amendment, the status of the claims is as follows:

Allowed claim(s): none

Rejected claim(s): 16, 21, 24-30, and 35

Claim(s) objected to: none

See 37 CFR 1.193(a)(2) which provides for the inclusion of the proposed rejection(s) detailed below in the Examiner's Answer if applicants elect to file an appeal to the Board of Patent Appeals and Interferences in this proceeding. To be complete, such rejections must be addressed in any brief on appeal.

Upon appeal and entry of the amendment:

Claims 16, 21, 24-30, and 35 would be rejected as follows:

(1) Claims 16, 21, 24, 25, 28, and 35 under 35 USC 112, first paragraph, for the reasons set forth the final Office Action mailed on May 3, 2004, paragraph 7, item (1).

(2) Claims 16, 21, 24, 26-30, and 35 under 35 USC 103(a) over US 5,292,609 (Yoshikawa) combined with US 5,179,171 (Minami), as evidenced by the Aldrich Catalog, page 1063, and

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Polymer Technology Dictionary, page 487, for the reasons set forth in the final Office action mailed on May 3, 2004, paragraph 10.

2. Applicants' arguments regarding the objection to the specification under 35 USC 132, set forth in the final Office action mailed on May 3, 2004 (CTFR050304), paragraph 3, item (2), have been addressed in the final Office action. See CTFR050304, paragraph 3, item (2) pages 8-9.

Applicants' arguments regarding the rejection of claims 16, 21, 24, 25, 28, and 35, as set forth in the amendment filed on Aug. 6, 2004, which will be entered upon the filing of an appeal, under 35 USC 112, first paragraph, set forth in CTFR050304, paragraph 7, item (1), are not persuasive for the reasons discussed in CTFR050304. Applicants further assert that the "term 'a' indicates only one, therefore the phrase compound having a double bond means that there is only one double bond." However, as discussed in CTFR050304, page 16, the disclosure of "a compound having a double bond" (emphasis added), when given is broadest and reasonable interpretation, is not limited to compounds having one double bond, but includes compounds having one or more than one double bond. For the reasons discussed in the rejection, the originally filed specification does not

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provide an adequate written description of the broad subgeneric species "alicyclic compound having one double bond" recited in the instant claims.

Applicants' arguments regarding the rejection of claims 16, 21, 24, 26-30, and 35, as set forth in the amendment filed on Aug. 6, 2004, which will be entered upon the filing of an appeal, under 35 USC 103(a) over Yoshikawa combined with Minami, set forth in CTFR050304, paragraph 10, are not persuasive for the reasons discussed in CTFR050304. As discussed in the rejection, the references do provide reason, suggestion, and motivation, to use Minami's cyclic olefin copolymer as the toner binder resin in Yoshikawa's toner. Yoshikawa does not limit its toner to comprising only styrene-based binder resins. See reference claim 1 of Yoshikawa, which recites a toner comprising "a vinyl-based polymer synthetic resin." Furthermore, as discussed in the rejection, Yoshikawa teaches that the toner binder vinyl-based polymer may be ethylene-based copolymers or alicyclic hydrocarbon resins. Yoshikawa teaches that the binder resin can be selected from 13 classes of polymers. In view of the reason, suggest, and motivation cited in the rejection, the choice of two classes of polymers from a list of 13 classes of polymers would have been obvious to a person having ordinary skill in the art within the meaning of 35 U.S.C. 103(a). The

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disclosure of a reference is not limited to its examples, or to its preferred embodiments. A reference is relevant for all that it teaches. See In re Heck, 216 USPQ 1038, 1040 (Fed. Cir. 1983). "In a section 103 inquiry, 'the fact that a specific [embodiment] is taught to be preferred is not controlling, since all disclosures of the prior art, including unpreferred embodiments, must be considered.'" Merck & Co. Inc. V. Biocraft Laboratories Inc., 10 USPQ2d 1843, 1846 (Fed. Cir. 1989) (quoting In re Lamberti, 192 USPQ 278, 280 (CCPA 1976)).

Yoshikawa's disclosure of "alicyclic hydrocarbon" resins and ethylene copolymers clearly encompass Minami's cyclic olefin copolymers obtained from ethylene and norbornene. As discussed in the rejection, Minami teaches cyclic olefin copolymers, which meet the cyclic polyolefin recited in the instant claims. Minami discloses that its copolymers have excellent thermal resistance in addition to excellent dielectric properties, mechanical properties, and transparency. Minami teaches that said copolymers can be used in electrophotographic toners. Accordingly, Minami provides reason, suggestion, and motivation to a person having ordinary skill in the art to use its cyclic olefin copolymer as the toner binder resin in Yoshikawa's toner. Based on the disclosures in Yoshikawa and Minami, a person having ordinary skill in the art would have recognized clearly

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that Minami's cyclic olefin copolymer can be used as a toner binder resin.

Accordingly, the rejection stands.